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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,806	06/26/2001	Yong Jin Chang	858-11 CIP	2661
23869	7590	10/20/2004	EXAMINER	
HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			COMSTOCK, DAVID C	
			ART UNIT	PAPER NUMBER
			3732	
DATE MAILED: 10/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/891,806

Applicant(s)

CHANG ET AL.

Examiner

David Comstock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2004 and 29 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-10,12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Terminal Disclaimer

The terminal disclaimer filed on 29 July disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of the 6,354,304 patent has been reviewed and is accepted. The terminal disclaimer has been recorded. However, this fails to place the application in condition for allowance in view of the rejections set forth below.

Affidavit under 37 CFR 1.131

The declaration filed on 28 January 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Nail Max 2000 reference.

The evidence submitted 28 January 2004 is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Nail Max 2000 reference. Applicant's representative states in the response filed 08 January 2004, on page 8, that certain embodiments were made "as early as May of 1999." Thus, there is ambiguity as to whether all of the embodiments shown are entitled to the date averred to in the declaration. In addition it is noted that the photograph presented as evidence of reduction to practice of the claimed invention prior to the Nail Max 2000 reference cannot be given any weight since there would be no way of verifying that the date shown in the corner of the document in fact correlates in any way to the date that the nails shown were invented. Taken together, a reasonable person could not accept this declaration as sufficient evidence of prior reduction to practice.

Claim Objections

Claim 5 is objected to because of the following informalities: line 1, "4" should be shown in strikethrough font to indicate deletion. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-6 and 18 are rejected under 35 U.S.C. 102(a) as being anticipated by Nail Max 2000 (cited by applicant).

Nail Max 2000 discloses a "Sparkled White French Nail" having an artificial nail with a nail body comprising a bed portion, a tip portion, and a dividing line between the bed portion and tip portion (see figure at page 81 near top right). From the figure, the dividing line appears to correspond to the transition of a natural nail from bed to tip. The nail bed portion appears to correspond in size and shape to the nail bed of a natural fingernail. The nail tip is painted with a continuous opaque decoration, i.e., white. The translation of the figure discloses and/or suggests that the material of the nail body is "clear," which is synonymous to transparent. Moreover, "clear" is defined by the *Webster's II New Riverside University Dictionary, The Riverside Publishing Company 1994*, as "Free from clouds, mist, or haze, " "Free from what dims, obscures, or

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darkens: TRANSPARENT.” The nail body further includes decorative designs over the body. The decorative designs look like glitter. The nail is applied with conventional adhesive.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nail Max 2000 (cited by applicant) in view of Agee, II et al. (D380,867; previously cited).

Nail Max 2000 discloses the claimed invention except for the dividing line at an angle. Agee, II et al. disclose a similar device having a dividing line at an angle relative to the natural dividing line to provide a decorative appearance and enhance the ornamental appearance of the nails (see Fig. 1, Title, and Claim). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the artificial nail and tip of Nail Max 2000 with a dividing line oriented at an angle relative to the natural dividing line, in view of Agee, II et al., in order to provide a decorative appearance and enhance the ornamental appearance of the nails.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nail Max 2000 (cited by applicant) in view of Chang 5,782,248; previously cited).

Nail Max 2000 discloses the claimed invention except for the transparent sealer. Chang discloses that an additional layer of clear polish can be applied to increase the strength and durability of the nails and improve their cosmetic appearance (see Abstract and col. 3, lines 35-39). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the nail of Nail Max 2000 with a transparent sealer, in view of Chang, in order to increase the strength and durability of the nails and improve their cosmetic appearance.

Claims 8 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nail Max 2000 (cited by applicant on PTO-1449) in view of Mast et al. (4,751,935).

Nail Max 2000 discloses the claimed invention except for the nail base (as opposed to the nail bed). Mast et al. discloses that artificial nails comprising nail *beds* (corresponding to the natural nail bed) and nail tip portions and those comprising nail *bases* (corresponding the the distal end of a fingernail) and nail tip portions are functionally equivalent structures, known in the art, for decorating fingernails (see Figs. 1, 4, and 5 and col. 6, lines 47-57; also see Nakata et al. [4,615,348; previously cited] at col. 1, lines 29-34 and Wood [5,704,375; cited by applicant]). Therefore, since these two nail decorations were functionally equivalent structures known in the art at the time of the invention, it would have been obvious to a person of ordinary skill to substitute artificial nails comprising nail bases and nail tip portions for artificial nails comprising nail beds and nail tip portions, as such is merely the substitution of functionally equivalent nail decorations. It also would have been obvious to apply a transparent sealer, also in

view of Mast, in order to protect the nail and make it last longer (see Mast et al. col. 1, lines 21-23 and col. 5, lines 22-24).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nail Max 2000 (cited by applicant) in view of Mast et al. (4,751,935; previously cited) as applied to claim 8 above, and further in view of Agee, II et al. (D380,867; previously cited).

The device of the combination of Nail Max 2000 and Mast et al. discloses the claimed invention except for the dividing line at an angle. Agee, II et al. disclose a similar device having a dividing line at an angle relative to the natural dividing line to provide a decorative appearance and enhance the ornamental appearance of the nails (see Fig. 1, Title, and Claim). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the artificial nail and tip of the combination of Nail Max 2000 and Mast et al. with a dividing line oriented at an angle relative to the natural dividing line, in view of Agee, II et al., in order to provide a decorative appearance and enhance the ornamental appearance of the nails.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nail Max 2000 (cited by applicant) in view of Bartolucci (3,982,551; cited by applicant).

Nail Max 2000 disclose the claimed invention except for the kit. Bartolucci discloses a kit 10 comprising artificial fingernails 14 and adhesive 50 (see Fig. 1). The kit makes the nails easier to use and provides the nails and necessary supplies in an aesthetically attractive, compact, complete, and ready-to-use manner (see col. 1, lines 1-22). It would have been obvious to one having ordinary skill in the art at the time the

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invention was made to provide the artificial nails of Nail Max 2000 in a kit, in view of Bartolucci, in order to make the nails easier to use and to provide the nails and necessary supplies in an aesthetically attractive, compact, complete, and ready-to-use manner. It also would have been obvious to provide the adhesive in the color pink since choosing an appropriate color is merely an obvious matter of design choice.

Claims 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nail Max 2000 (cited by applicant) in view of Bartolucci (3,982,551; cited by applicant), as applied to claim 15 and further in view of Ferrigno (4,450,848; cited by applicant).

The device of the combination of Nail Max 2000 and Bartolucci discloses the claimed invention except for the transparent acrylic filler. Ferrigno discloses an artificial fingernail forming method comprising applying a transparent filler having an acrylic powder along with a liquid cyanoacrylate adhesive rearward of the tip, allowing the combination to harden, and buffing it. This allows the artificial nail to remain on the natural fingernail longer and increases the potential market for the device, i.e., to men etc. (see col. 1, lines 15-29 and 42-53 and col. 2, Examples). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the artificial nail applying method Nail Max 2000 and Bartolucci with a step of applying an acrylic filler composed of powder and liquid cyanoacrylate, in view of Ferrigno, in order to allow the artificial nail to remain on the natural fingernail longer and increase the potential market for the device.

Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nail Max 2000 (cited by applicant).

Nail Max 2000 disclose the claimed invention except for the adhesive being the color pink. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the adhesive in the color pink since choosing an appropriate color is merely an obvious matter of design choice.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nail Max 2000 (cited by applicant) in view of Ferrigno (4,450,848; cited by applicant).

Nail Max 2000 disclose the claimed invention except for the transparent acrylic filler. Ferrigno discloses an artificial fingernail forming method comprising applying a transparent filler having an acrylic powder along with a liquid cyanoacrylate adhesive rearward of the tip, allowing the combination to harden, and buffing it. This allows the artificial nail to remain on the natural fingernail longer and increases the potential market for the device, i.e., to men etc. (see col. 1, lines 15-29 and 42-53 and col. 2, Examples). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the artificial nail applying method of Mast et al. with a step of applying an acrylic filler composed of powder and liquid cyanoacrylate, in view of Ferrigno, in order to allow the artificial nail to remain on the natural fingernail longer and increase the potential market for the device.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.



D.C. Comstock
18 October 2004



Cary E. O'Connor
Primary Examiner